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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,312	07/06/2001	Harald Hess	VOI0131.CON	5684

7590

03/27/2002

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EXAMINER

FULLER, ERIC B

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

ME-7

Office Action Summary	Application No.	Applicant(s)	
	09/900,312	HESS, HARALD	
	Examiner	Art Unit	
	Eric B Fuller	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/301,194.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 seems to be claiming that the moistening medium is atomized in the spraying mechanism along with the coating medium, as in the coating medium and moistening medium are mixed upstream from the spraying device. Claim 11 seems to be claiming that the moistening medium is mixed with the coating medium after the coating medium has all ready been atomized. However, as worded, these two claims are confusing. In claim 4, confusion stems from the word "utilization". In claim 11, confusion stems from the fact that "the atomized coating medium" only has an implied antecedent basis. Clarity is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundholm et al. (WO 94/11116) in view of Rosenberger et al. (US 5,993,913).

Sundholm teaches a process where a spray device, which has an application area, is oriented towards a fibrous web. The spray device atomizes the coating material and applies it to the web. A doctor blade is then used in order to sufficiently smooth the coating onto the web (page 6, line 17). Additionally, it is taught that the doctor blade leads to wasted coating material and that replacement of the doctor blade is time consuming (page 1, lines 25-28). Although Sundholm teaches a method that reduces the amount of wasted coating material and reduces the frequency of doctor blade replacement, it does not teach a method that is sufficiently smooth enough to eliminate both. Thus, there is a desire to achieve smoother coatings in the art of spray coating fibrous webs.

Rosenberger teaches a method where a spray device, which has an application area, is oriented towards a substrate. The spray device atomizes a mixture of water (applicant's moistening medium) and coating medium (column 2, lines 52-63; column 5, lines 1-5). Measuring the humidity and adjusting the amount of water being mixed into the coating medium, prior to atomization, maintains the atmosphere around the nozzle. Rosenberger teaches that the water is added in order to reduce viscosity and increase flowability of the coating agent, which results in smoother surfaces (column 3, lines 41-45; table 1).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the method taught by Rosenberger in order to coat

the fibrous web of Sundolm. By doing so, the smoothness of the fibrous web would be increased.

As to claims 2 and 3, according to Rosenberger, the moistening medium is in the form of a liquid when being mixed with the coating material. Since humidity is being measured and controlled in the atmosphere, it is inferred that the liquid, which is water, is being transformed into water vapor as it is passed through the nozzle (column 2, lines 19-31; column 3, lines 42-56).

As to claim 4, the water is being mixed upstream from the nozzles (figure). Therefore the spraying step utilizes the moistening medium.

As to claims 8 and 10, the spray device can be an electrostatic rotary atomizing device.

Claims 1-3, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundholm et al. (WO 94/11116) in view of Behmel et al. (US 4,396,651).

Sundholm teaches a process where a spray device, which has an application area, is oriented towards a fibrous web. The spray device atomizes the coating material and applies it to the web. A doctor blade is then used in order to sufficiently smooth the coating onto the web (page 6, line 17). Additionally, it is taught that the doctor blade leads to wasted coating material and that replacement of the doctor blade is time consuming (page 1, lines 25-28). Although Sundolm teaches a method that reduces the amount of wasted coating material and reduces the frequency of doctor blade

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replacement, it does not teach a method that is sufficiently smooth enough to eliminate both. Thus, there is a desire to achieve smoother coatings in the art of spray coating fibrous webs.

Behmel teaches a process where a spray device, which has an application area, is oriented towards a substrate. The spray device atomizes the coating material in a main nozzle and atomizes an additive in an ancillary nozzle (abstract). The additive is water (inherently a moistening medium). The spray device causes mixing of the atomized water with the atomized coating material to create a heterogeneous mixture. The heterogeneous mixture allows for a high degree of wetting of the substrate, which provides for a smooth coating (column 3, lines 18-40; column 2, lines 1-29). The atmosphere is maintained by measuring the humidity and around the nozzle and adjusting the water flow rate (column 3, lines 8-15).

it would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the method taught by Behmel in order to coat the fibrous web of Sundolm. By doing so, the smoothness of the fibrous web would be increased.

As to claims 2 and 3, according to Behmel, water, which is a liquid, is flowed into the ancillary nozzle. Since humidity is being measured and controlled in the atmosphere, it is inferred that the water is being transformed into water vapor as it is passed through the nozzle (column 3, lines 6-15).

As to claims 8 and 10, the spray device can be an electrostatic rotary atomizing device (column 2, line 45 and 61-66).

As to claim 11, as taught above, both the water and the coating medium are atomized prior to mixing. This reads on supplying the moistening medium to the atomized coating medium.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 8, 10, and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S.

Patent No. 6,248,407 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other.

All the limitations in the present claims, except for one, are met by the claims of the patent. The limitation not met by the patent is the limitation stating, "orienting said spray device such that said application area is directed toward said fiber material web." However, this limitation would have been obvious at the time the invention was made to a person having ordinary skill in the art, as it is necessary in order to coat the substrate.

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Conclusion

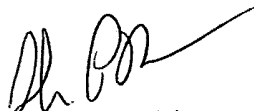
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



EBF
March 20, 2002



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